

Appl. No. 10/066,023
Amdt dated November 20, 2003
Reply to Office Action of June 20, 2003

REMARKS/ARGUMENTS

Claims 21-25 were pending, all of which stand rejected. Claims 4-20 and 26-30 have been withdrawn from consideration and are canceled without prejudice in this amendment. Claims 1-3 were previously canceled. Claims 31-36 have been added.

Title

The title was objected to as not descriptive of the claimed invention. The title has been amended to overcome this objection.

Specification

The Examiner objected to the specification on the basis that the cross references to the related applications need to be updated. The Examiner made the same objection in the Office Action of August 9, 2002, and the Applicants updated the cross references to the related applications in the paragraphs beginning at page 1, line 6, and page 14, line 5, in their response of December 19, 2002. This response is believed to overcome the rejection. If the Examiner is aware of any additional cross references that need to be updated, the Applicants would appreciate a citation to their location in the specification.

Claim Rejections – 35 U.S.C. §101

Claims 21-25 were rejected on double patenting grounds over Claims 1-3 of U.S. Patent No. 6,256,200.

This rejection is clearly erroneous. To cite just one example, Claim 1 of U.S. Patent No. 6,256,200 recites a "notch being formed in the lead." Claims 2 and 3 of U.S. Patent No. 6,256,200 depend from Claim 1. There is no recitation of a "notch" in any of Claims 21-25 of the present application.

Thus, Claims 1-3 of U.S. Patent No. 6,256,200 clearly do not claim the "same invention" as Claims 21-25 of this application.

Claim Rejections – 35 U.S.C. §103

Claim 21 was rejected under 35 U.S.C. §103(a) as being unpatentable over Wakefield, specifically Fig. 7 of Wakefield. This rejection is respectfully traversed.

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Fig. 7 of Wakefield shows a chip 13 that is positioned between frame leads 20 and a "suitably transparent body 110," which "may be glass or a suitably transparent plastic" (col. 7, lines 65-66). There is no indication or suggestion in Wakefield that body 110 functions as a heat sink or that it is electrically conductive. Moreover, there is no indication or suggestion in Wakefield that chip 13 has a terminal on the side which faces the transparent body 110.

Contrary to the Examiner's statement at page 4, lines 30-32, of the Office Action, Wakefield does not teach that body 110 is a "metal heat sink" and, as a glass or plastic body, it could not be "in electrical contact" with a terminal on the chip.

In contrast, Claim 21 recites, inter alia, "a metal heat sink in thermal contact with the lower principal surface of the die and in electrical contact with a first terminal on the lower principal surface of the die" (emphasis added). Claim 21 is therefore clearly allowable over anything taught or suggested in Fig. 7 of Wakefield.

Claims 22-25 were not rejected over Wakefield and thus the Applicants presume that the Examiner considers these claims to be allowable. In any event, Claims 22-24 depend from Claim 21, and Claim 25 recites, inter alia, "said heat sink being bonded to said die and said die being bonded to said lead." Only Figs. 1-3, 6 and 8 of Wakefield teach a "body 10 of a thermally conductive material" (col. 4, line 4), and none of these drawings teaches or suggests the "sandwich" structure recited in Claim 25.

New Claims 31-36 depend from Claim 21 and are therefore allowable for the reasons stated above. New Claims 31-36 are supported at least by Figs. 9A-9D and 10A-10L and the accompanying text of this application.

Applicants note in reviewing the file that in the Office Action of August 9, 2002, Claims 4-12 were "rejected under the judicially created doctrine of double patenting" over claims 1 to 3 of U.S. Patent No. 6,256,200 and "provisionally rejected" on the same ground over claims 1 to 3 of copending Application 09/898212" (now U.S. Patent No. 6,452,802). In the Response filed on December 19, 2002, the Applicants indicated that they were filing terminal disclaimers to overcome these rejections (see page 6, lines 22-25), but it appears that the terminal disclaimers may have been inadvertently omitted from the materials actually filed. If so, the Applicants apologize for the oversight. In any event, in the next Office Action (March 18, 2003) the Examiner imposed an election requirement pursuant to

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which the species upon which Claims 21-25 were readable was elected (see Response dated April 8, 2003). Thus it appears that the error has become moot by reason of the non-election of Claims 1-12. As indicated above, the double patenting rejection in the current Office Action is improper.

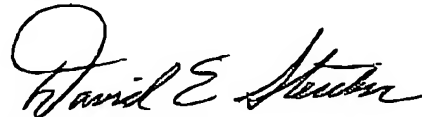
For the above reasons, Applicants respectfully request allowance of Claims 21-25 and 31-36. Should the Examiner have any questions concerning this response, the Examiner is invited to call the undersigned at (408) 982-8200, ext. 1.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office to the fax number 703-308-7722 on November 20, 2003.

 11/20/03
Attorney for Applicant(s) Date of Signature

Respectfully submitted,



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